



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,062	06/15/2001	Holger Birk	016790-0422	5177

22428 7590 08/01/2003

FOLEY AND LARDNER
SUITE 500
3000 K STREET NW
WASHINGTON, DC 20007

EXAMINER

ROBINSON, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

2872

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/881,062

Applicant(s)

BIRK ET AL.

Examiner

Mark A. Robinson

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 May 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 12, 14, 21 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13, 15-20, 22, 23 and 25-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 2872

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-3, 5-7, 19, 20, 22 and 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Kafka et al 6236779.

These claims stand rejected as discussed in the previous office action.

Claim Rejections - 35 USC § 103

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. Claims 4, 8, 23, 25-27 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka et al.

These claims stand rejected as discussed in the previous office action.

5. Claims 9-11, 13 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kafka et al in view of Simon et al 5995281.

These claims stand rejected as discussed in the previous office action.

Art Unit: 2872

Terminal Disclaimer

6. The terminal disclaimer filed on 5/23/03 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of 6,567,164 has been reviewed and is accepted. The terminal disclaimer has been recorded.

Double Patenting

Claims 1-11,13,15-20,22,23,25-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 15,16,18, etc. of copending Application No. 09/881,046, claims 5,9, etc of copending Applicant No. 09/881,048, claims 5-13 of copending Application No. 09/881,049, claims 17-19, etc. of copending Application No. 09/881,212, and claims 6,7,11, etc. of copending Application No. 09/882,355. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the present application are merely broader than or are obvious variations of the claims of the copending applications.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 2872

Response to Arguments

7. Applicant's arguments filed 5/23/03 have been fully considered but they are not persuasive.

Applicant has argued that Kafka's fiber does not spectrally spread the light passing through.

However, Kafka clearly states in column 2 that dispersion is present in the fiber (as is true of any optical fiber). Dispersion is equivalent to spectral spreading of light, and since Kafka's fiber disperses the light (at least to some extent), it thus spectrally spreads the light. Note that this is all that is required by the claims. Note also that Kafka discloses band-gap properties in column 2 of the disclosure.

Applicant has further argued that Kafka does not disclose a scanning microscope.

However, Kafka does in fact teach use of his device with a scanning microscope as disclosed in column 2 lines 66-67 and column 3 lines 9-12.

Applicant has further disputed the alleged examiner's position, i.e. "that tapered fibers *for the spectral spreading of light* were known in the art."

However, this was not the examiner's position. Applicant's attention is directed to the previous office action paragraph 6

Art Unit: 2872

where it was asserted that "tapered optical fibers are well known in the art." Accordingly, this argument is moot.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Robinson whose telephone number is (703) 305-3506.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Dunn, can be reached at (703) 305-0024. The fax phone number for the

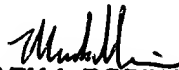
Art Unit: 2872

organization where this application or proceeding is assigned is
(703) 308-7722.

Any inquiry of a general nature or relating to the status
of this application or proceeding should be directed to the
receptionist whose telephone number is (703) 308-0956.

MR

7/30/01


MARK A. ROBINSON
PRIMARY EXAMINER